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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/925,451      | 08/10/2001  | Takao Uehara         | S-2490              | 4601             |

7590 09/05/2003

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| EXAMINER |
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SHOSHO, CALLIE E

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1714

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |               |  |
|------------------------------|------------------|---------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)  |  |
|                              | 09/925,451       | UEHARA ET AL. |  |
|                              | Examiner         | Art Unit      |  |
|                              | Callie E. Shosho | 1714          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 June 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 6/3/03.

**Claim Rejections - 35 USC § 102**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10158336 or Simms (U.S. 4,219,632).

The rejection is adequately set forth in paragraph 2 of the office action mailed 3/4/03 and is incorporated here by reference.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Turpin et al. (U.S. 4,608,314).

The rejection is adequately set forth in paragraph 3 of the office action mailed 3/4/03 and is incorporated here by reference.

5. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassatta et al. (U.S. 4,533,681) or EP 610534.

The rejection is adequately set forth in paragraph 4 of the office action mailed 3/4/03 and is incorporated here by reference.

6. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamura et al. (U.S. 5,576,406).

The rejection is adequately set forth in paragraph 5 of the office action mailed 3/4/03 and is incorporated here by reference.

**Response to Arguments**

7. Applicants' arguments regarding Franchina et al. (U.S. 6,479,605) have been considered but they are moot in view of the discontinuation of this reference against the present claims.

8. Applicants' arguments filed 6/3/03 have been fully considered but, with the exception of arguments relating to Franchina et al., they are not persuasive.

Specifically, applicants argue that none of the references cited by the examiner are applicable against the present claims because while each of the references discloses copolymer as presently claimed, none of the references teach a method for preventing a whitening phenomenon for solvent-borne paints as now required in all the present claims. Applicants argue that when claims are drawn to new method of using either an old or obvious composition, wherein the method has unobvious beneficial or useful effects, the new method claims are patentable even though the composition itself could not be patented.

It is agreed that there is no explicit disclosure in any of the references that the copolymer prevents a whitening phenomenon for solvent-borne paints. However, it is noted that, as set forth in MPEP 2112.02, the discovery of a new use of an old structure based on unknown properties only "might" be patentable as a process of using. This portion of the MPEP states that "when the

claim recites using an old composition or structure and the “use” is directed to a result or properties of that composition or structure, then the claim is anticipated”, *In re May* 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). In *May*, the courts held applicants had merely found a new property of the compound and that such a discovery does not constitute a new use. Thus, the present claims remain anticipated by the prior art.

This is directly applicable to the present situation wherein the present method claims only recite a property or result of the copolymer, i.e. preventing a whitening phenomenon for solvent-borne paints. As discussed above, the discovery that the claimed copolymer has a new property, i.e. preventing a whitening phenomenon for solvent-borne paints, does not constitute a new use.

Further, it is noted that the recitation in the claims of method “suitable for” preventing a whitening phenomenon for solvent-borne paints is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that all the cited prior art disclose copolymer as presently claimed, it is clear that the copolymer would be capable of performing the intended use, i.e. preventing a whitening phenomenon for solvent-

borne paints, presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

In light of the above, it is the examiner's position JP 10158336, Simms, Turpin et al., Cassatta et al., EP 610534, and Yamamura et al. remain relevant references against the present claims.

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Callie Shosho*

Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
9/4/03